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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/890,830 | 08/06/2001 | Takeshi Natsuno | 9683/89 | 8170 |

7590 09/06/2006

Brinks Hofer Gilson & Lione
PO Box 10395
Chicago, IL 60610

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| EXAMINER |
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DOAN, PHUOC HUU

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| ART UNIT | PAPER NUMBER |
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2617

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|----------------------------------|--|
| Office Action Summary | Application No. 09/890,830 | Applicant(s) NATSUNO, TAKESHI | |
| | Examiner PHUOC H. DOAN | Art Unit 2617 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-24 and 35-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16-24 is/are allowed.
- 6) ☒ Claim(s) 35-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 35-38 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 35-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Adcock (US Patent No: 7,024,385).

As to claim 35, Adcock discloses a wireless telephone (100) that comprises: a memory that stores information “col. 8, lines 30-35” for effecting financial services provided by multiple financial institution (col. 7, lines 45-60); an instrument adapted to be used with an external instrument reader (col. 6, lines 35-42); an information reader that selectively reads out information from the memory according to a selection of a financial institution among the multiple financial institution (col. 7, lines 45-67); and an instrument control that reconfigures the

instrument (col. 10, lines 27-30), based on the readout information (col. 7, lines 55-60), for effecting the financial services provided by the selected financial institution (col. 7, lines 45-60, col. 10, lines 27-30).

As to claim 36, Adcock further discloses wherein the instrument is a magnetic card (col. 8, lines 53-54), and the instrument control magnetically records the readout information on the magnetic card (col. 9, lines 20-25).

As to claim 37, Adcock further discloses wherein the instrument is a display (col. 7, lines 57-58) and the instrument control displays the readout information in bar codes on the display (col. 8, lines 50-55).

As to claim 38, Adcock further discloses wherein the instrument is an infrared emitter (col. 7, lines 9-10) and the instrument control controls the infrared emitter so that it outputs the readout information in infrared (col. 7, lines 9-22).

Allowable Subject Matter

4. Claims 16-24 are allowed.

As to claim 16, the prior art either alone or in combination do not disclose a communication network which communicates with a mobile terminal that has communication functionality and financial functionality of effecting financial services provided by at least one financial institution, the communication network comprising: a memory in which an identification of the mobile terminal is

recordable along with information concerning of the mobile terminal as to whether to disable the financial functionality accorded to the mobile terminal; a memory control that, in response to a report notifying a possibility of fraud which may be committed with the financial functionality of the mobile terminal stores in the memory in connection with the mobile terminal information indicating that the financial functionality has to be disabled; a terminal control that if the memory indicates that the financial functionality has to be disabled, sends a disabling signal a communication control that communicates data with the mobile terminal and the at least one financial institution to have the financial services implemented; independently of the at least one financial institution, to the mobile terminal to which the financial functionality is accorded, wherein the disabling signal causes the mobile terminal to at least partially disable either or both of the communication functionality and the financial functionality of effecting financial services.

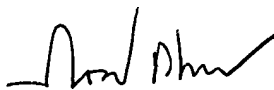
Dependent claims 17-24 are allowed by the virtue of the dependency in independent claim 1.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PHUOC H. DOAN whose telephone number is 571-272-7920. The examiner can normally be reached on 9:30 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, GEORGE ENG can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Phuoc Doan
08/24/06

JEAN GELIN
PRIMARY EXAMINER

